

REMARKS

In the Office Action mailed December 21, 2004, the Examiner rejected claims 15-25, 27, 29 and 32-35 and objected to claims 26, 28, 30 and 31. By way of the foregoing amendments and the markings to show changes, Applicant have amended claim 15, canceled claims 26 and 28 and added new claims 36-38. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Claim 15 and its dependents

The Office Action indicated dependent claims 26 and 28 (dependent on claim 15) as being allowable if written in independent form. Applicants thank the Examiner for the indication of allowable subject matter. Applicants have amended claim 15 to include the language, "the curing agent, the accelerator or both being selected from an cycloaliphatic amine or an amidoamine". This language essentially provides a selection between the language of claim 26 or the language of claim 28 within independent claim 15. On this basis, claim 15 should be allowable.

Claim 16 and its dependents

The Office Action rejected claim 16 and its dependents for obviousness type double patenting over U.S. Patent 6,682,818. Applicants have submitted a terminal disclaimer herewith to overcome this rejection. Claim 16 and its dependents should now be allowable.

Claim 17 and its dependents

Applicants traverse the rejection of claim 17 and its dependents on the ground that the Office Action does not establish a prima facie case of obviousness against claim 17.

The MPEP 2143.03 reads, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a

claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Additionally, Office Action suggests that, "...Gerace et al. disclose a sealant material [having]...a hydrocarbon of polymethyl methacrylates and ethacrylates..." However, an acrylate typically includes an ester that also typically includes an acrylic acid, an organic radical or both. Thus, the skilled artisan would not refer to polymethyl methacrylates and ethacrylates as hydrocarbons. As such, the Office Action does not properly assert a prima facie case of obviousness against claim 17 and its dependents and Applicants request that the rejection of claim 17 and its dependents be withdrawn.

The Office Action admits that Gerace et al. does not disclose the amount of filler claimed by Applicants. The Office Action then suggests, however, that, "Although the amount of Gerace et al. is not included in Applicant's claim range, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

have added a variety of amounts of filler, including an amount of filler as claimed, due to the non-reactive nature of the filler.”

Applicants contend that this statement fails to assert a prima facie case of obviousness because it fails to provide a motivation for the skilled artisan to provide an amount of filler according to Applicants’ claimed range. The “non-reactive nature of the filler” does not actually provide a specific motivation to use Applicants’ particular claimed range. Moreover, Gerace et al. is directed toward a material that is flowable upon application. Gerace et al. reads at page 5, lines 16-19, “the compositions are able to flow at application temperature with the proper wet-out onto a surface...” Applicants contend that the skilled artisan would typically be at least less likely to employ filler amounts as claimed by Applicants for the particular compositions of Gerace et al.

In view of the above, Applicants request that the rejection of claim 17 and its dependents be withdrawn.

Furthermore, Applicant points out that it would likely be improper to present a final rejection of claim 17 on a grounds alternative to that already presented since applicants have not amended those claims in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee...” MPEP 706.07(a)

Thus, any new grounds of rejection, “that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee...” would be improper.

New Claims

Applicants have added new claims 36-38 to address various aspects of the present invention.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

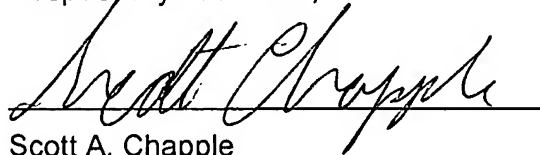
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

Dated: 14 March, 2005



Scott A. Chapple
Registration No. 46,287
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215